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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sedaka

Serial No. 75/752,783

Sanford J. Asman, Esq. for Neil Sedaka.

Ysa de Jesus, Trademark Examining Attorney, Law Office 101 (Angela Wilson, Acting Managing Attorney).

Before Quinn, Hohein and Chapman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Neil Sedaka has filed an application to register the term "SEDAKA" as a trademark for "prerecorded music, namely[,] a series of musical sound recordings."[1]

Registration has been finally refused under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that as used on the specimens, the term "SEDAKA" does not function as a trademark for applicant's goods. Instead, according to the Examining Attorney, such term is used in an

[1] Ser. No. 75/752,783, filed on July 16, 1999, which alleges a date of first use anywhere and in commerce of December 31, 1958.

informational manner to identify the author of certain songs on applicant's series of musical sound recordings.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

As a preliminary matter, applicant in his brief asserts by way of background that:

> Applicant has been an icon in the music business, as a songwriter, singer, and performer, for over forty (40) years. During that time, applicant has been known as "SEDAKA" by millions of fans around the world. While applicant's name has been synonymous with him and his music, recent trends on the Internet have allowed others to use his name to register domains which have been used for a variety of nefarious purposes. Accordingly, applicant has found the need to secure federal trademark registration of his name in order to prevent interlopers, some of whom have registered [I]nternet domains solely to trade off the long[-]standing good will applicant has garnered, so as to enable them to use applicant's name to lure the unsuspecting public to sites which sell products with which applicant neither has, nor wants any association.
>
> In furtherance of such efforts, applicant registered his mark "NEIL SEDAKA" as U.S. Trademark Reg. No. 2,318,667 in International Class 041 for "entertainment in the nature of live music, concerts, prerecorded music, and personal appearances by Neil Sedaka", and he filed the present application [to] secure protection on his "SEDAKA" mark.

Relying on In re Polar Music International AB, 714 F.2d 1567, 221 USPQ 315, 318 (Fed. Cir. 1983), which among other things held in a two-to-one decision that the name of the musical group "ABBA" was registrable as a trademark for sound recordings

because the evidence established that "the mark 'ABBA' indicates not just the source of the performance but a source of the records and tapes and the sound recorded thereon," applicant contends with respect to the refusal to register that such case "makes it clear that the 'SEDAKA' ... name can function as a trademark in the case of music recordings, and that such name clearly projects to purchasers the source of the goods."[2] The Examining Attorney's assertion that, as used on the specimens, the term "SEDAKA" does not function as a trademark for applicant's goods but is used, instead, only in an informational manner to identify the author of certain songs on applicant's series of musical sound recordings is misplaced, according to applicant, because:

> [T]here can be no doubt that every trademark is "informational". That a mark is "informational" to designate and distinguish the goods of one person from those of another, is precisely the purpose of having and registering trademarks. The Examining Attorney has confused that which is

[2] It is noted, however, that unlike the present appeal, the record in *Polar Music* contained a portion of an agreement licensing the mark at issue to a record company and requiring "appellant to produce and deliver ... master recordings embodying the performances" of the musical group. 221 USPQ at 316. The court, in particular, pointed out that, "[b]y express provisions of the license, appellant controls the nature and quality of the goods"; that the recording company "recognizes appellant's ownership" of appellant's mark; and that, under the agreement, the appellant "is solely responsible for all recording costs incurred in the production of the masters, and is solely responsible for paying the artists and all others in respect of sales of recordings derived from the masters." Id. Nonetheless, the Examining Attorney concedes in her brief that applicant exercises control over the nature and quality of the goods for which he seeks registration of his "SEDAKA" mark, stating that she "has never inquired about the applicant's control over the nature and quality of the goods" because, citing TMEP §1202.09(a) "it is only necessary to inquire" about such "if information in the [application] record [clearly] contradicts the applicant's verified statement that it is the owner of the mark or entitled to use the mark."

> informational ... [with the fact that such also serves] to designate the source of particular goods (*i.e.*, "SEDAKA" to identify Neil Sedaka as the source of a series of sound recordings) ....

The record in this case, besides containing, among other things, an article which provides biographical information on applicant and Internet excerpts listing various recordings on which applicant has performed, also includes a declaration from applicant in which he states that "I have been engaged in the music industry, as a performer, recording artist, composer, and lyricist for over forty years"; that "[m]y name, and marks, 'NEIL SEDAKA' and 'SEDAKA' are recognized throughout the world, and they are associated with music which I have written, my recordings, and my personal appearances"; that "I have composed both the music and the lyrics for numerous songs, including those shown on the specimens submitted"; and that "[e]ach of the songs in which I was the sole author of both the music and the lyrics, carries my trademark, 'SEDAKA.'"

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines a "trademark" as "any word, name, symbol, or device, or any combination thereof," which serves "to identify and distinguish [a person's] ... goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." It is well settled, however, that not all words, designs or symbols used in the sale or advertising of goods function as trademarks, regardless of an applicant's intent that they do so. 1 J. McCarthy, McCarthy on Trademarks & Unfair Competition, Section 3:3 (4th ed. 2003). Rather, in order to be

protected as a valid mark, a designation must create "a separate and distinct commercial impression, which thereby performs the trademark function of identifying the source of the goods to the customers." In re Chemical Dynamics, Inc., 839 F.2d 1569, 5 USPQ2d 1828, 1829-30 (Fed. Cir. 1988). A term or name does not function as a trademark unless it is used in a manner which projects to purchasers a single source of the goods. In re Morganroth, 208 USPQ 284, 287 (TTAB 1980). Thus, as set forth in In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 215-16 (CCPA 1976) (italics in original; citations and footnote omitted):

> The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify. ....
>
> An important function of specimens in a trademark application is ... to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used *as a trademark* with respect to the goods named in the application. ....

In the present case, applicant has submitted specimens showing the name "SEDAKA" underneath various song titles on three separate sound recordings consisting of compact discs entitled "THE IMMACULATE NEIL SEDAKA," "TIMELESS" (subtitled "THE VERY BEST OF NEIL SEDAKA") and "The Singer & His Songs NEIL SEDAKA."[3]

[3] Although the record also contains as a specimen a fourth compact disc which is entitled "SEDAKA'S BACK," such specimen uses the name "Neil Sedaka" instead of "Sedaka" to designate the author of certain songs on the album and thus is not germane to the ground of refusal herein.

For example, the album "THE IMMACULATE NEIL SEDAKA" demonstrates use of the name "SEDAKA" in connection with the titles of two of the 16 songs thereon as follows:[4]

> STANDING ON THE INSIDE
> SEDAKA
>
> and
>
> LONELY NIGHT (ANGEL FACES)
> SEDAKA.

Such manner of use, according to the Examining Attorney, "merely serves as an indication of the particular song's authorship." While agreeing with applicant that it is a "common practice" in the recording industry "to show the composer/lyricist of a particular song on the line underneath the song's title" on the list of contents of the recording, she maintains that, contrary to applicant's position, "a consumer of an artist's pre-recorded compact disc will not recognize a name underneath the title of a particular song as a trademark for that sound recording." Instead, the Examining Attorney insists, "the consumer will recognize it as an indication of authorship."

Furthermore, as to the manner of use of the name "SEDAKA" as illustrated by the specimens, the Examining Attorney accurately points out that (footnote omitted):

> There are additional reasons why the mark would not be perceived as a trademark.

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[4] Other song titles, by contrast, show use in the same manner of such names as "SEDAKA/GREENFIELD" for the tunes "SING ME," "OH CAROL," "STAIRWAY TO HEAVEN," "LITTLE DEVIL" and "CALENDAR GIRL"; "GREENFIELD/SEDAKA" for the songs "HAPPY BIRTHDAY SWEET SIXTEEN," "LOVE WILL KEEP US TOGETHER" and "BREAKING UP IS HARD TO DO"; and "SEDAKA/CODY for the tunes "LAUGHTER IN THE RAIN," "NEW YORK CITY BLUES," "SOLITAIRE," "SAD EYES," "BAD BLOOD" and "IMMIGRANT."

> For one, the mark appears buried in text with other informational matter. In the ... compact disc, TIMELESS[, which is subtitled] THE VERY BEST OF NEIL SEDAKA, the proposed mark SEDAKA appears underneath various songs in the compact disc. Next to that, [there] is the copyright symbol for phonorecords, the year in which it was recorded and the holder of the copyright. For example, track one of said compact disc [is listed as follows].
>
> 1. DESIREE
> (SEDAKA)(P) 1982 Neil Sedaka/Flying Music
>
> The mark is amongst other informational elements. The informational elements are non-distinctive words and symbols that describe copyright information rather than identify a single source of origin for the sound recordings. The use of the letter P for example, is the copyright notice for phonorecords embodying a sound recording. The use of the proposed mark in a closely related manner to these elements adds to the impression that SEDAKA is additional copyright information and/or informational matter. Thus, the mark fails to function as a trademark because it is informational as used on the specimens and does not clearly project to purchasers a single source for sound recordings.

We agree that, as cogently explained by the Examining Attorney, the name "SEDAKA" is not used on the specimens in a manner calculated to project to consumers and prospective purchasers of sound recordings an indication of the source or origin of such goods. Instead, due to its manner of use underneath the titles of certain songs which appear as part of the list of the contents of the music contained on each compact disc, the name "SEDAKA" merely informs customers who wrote such songs, given the common practice, to which the purchasing public is accustomed, of displaying on sound recordings the name(s) of the composer/lyricist(s) of a song in direct association with the

song's title. Consequently, as used on the specimens, the name "SEDAKA" does not function as a trademark for applicant's goods. Cf. In re Chicago Reader Inc., 12 USPQ2d 1079, 1080 (TTAB 1989) ["the name 'CECIL ADAMS' as used in the specimens of record [as a byline at the bottom of a newspaper column bearing the title 'THE STRAIGHT DOPE'] merely serves to identify the author of the article and is not used nor would be recognized as a trademark identifying and distinguishing applicant's column"].

Decision: The refusal to register is affirmed.